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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,886	10/21/2003	Rodney George Wade	CULLE-14	2767

23599 7590 12/07/2005

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EXAMINER

PRICE, CRAIG JAMES

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

THK

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/688,886		WADE, RODNEY GEORGE	
	<b>Examiner</b>		<b>Art Unit</b>	
	Craig Price		3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2003 and 02 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/2/2004</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

The specification incorporates Australian Patent 692835 by reference. In addition, this appears to be the acceptance number, not the document number.

### ***Specification***

2. The abstract of the disclosure is objected to because, the abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. Correction is required. See MPEP 608.01(b).

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: The claimed limitation on line 19, "sit" should be --site--.. Appropriate correction is required.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "plurality of floating balls within the collection chamber", as recited in claim 10, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Art Unit: 3753

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Item number 28, as disclosed in the specification in Column 6, line 29, is not shown on the details provided. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3753

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed limitation, " between 0.0005 for light pollution locations", in lines 19 and 20, is indefinite in that any range could be used for the pollution factor variable. The total range of the pollution factor considered for the chamber having a rainwater carrying capacity is not completely claimed.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,2,3,5,8, and 9 are rejected under 35 U.S.C. 102(b) as being unpatentable by Wade (AU-B-16551/95), i.e., Applicant's prior art, APA.

Regarding claims 1,2,3,5,8 and 9, APA discloses a first flush water diverter comprising a T-piece (6) with associated rainwater collection chamber, which T-piece is adapted for connection in a rainwater flow path to intercept the flow of rainwater from a roof into a downpipe or directly to a storage or usage area, the collection chamber (1) including a float (5) which seals on a seat adjacent a T-piece inlet to the collection chamber when the collection chamber is charged with rainwater and having a diameter

Art Unit: 3753

which is an integral multiple of the diameter of the T-piece inlet , the collection chamber is a pvc tube having a diameter of approximately 300 mm (Col. 6, Lns. 1-5), the pvc tube has a length of between about 225 mm and 2005 mm (Col. 6, 14-19), and wherein the collection chamber includes an outlet and associated flow control valve (12) to regulate the flow of diverted rainwater from the collection chamber, and wherein a hose connection (11) is fitted to the flow control valve as shown in Figure 1, wherein a filter screen (15,16) is provided at the outlet as seen in Figure 2, wherein the float is a ball which freely floats on the surface of the rainwater which collects in the collection chamber as shown in Figure 5 and in (Col. 4, Lns. 2 and 3), and a collection chamber having a capacity defined by the equation in the form of fall pipe volumes of 5 to 100 litres (Col. 6, Lns. 6-14). The equation in claim 1, having the PF, pollution factor, being between 0.0005 and any number allows PF to be any number. Therefore for any roof area any capacity can be obtained. APA suggests possible/suitable capacities.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Sill (US 1,460,613).

Regarding claims 4, and 6, APA teaches all of the claimed invention, but lacks the collection chamber is adapted for support on a stand or for connection to a wall or post and lacks a conical cap connects the T-piece to the collection chamber.

Firstly, Sill teaches the use of a rain water supply system on a stand, as seen in Figures 1 and 2.

In view of the Sill patent, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the collection chamber of Wade with the stand of Sill in order to provide a collection chamber which would be out of the reach of small children for safety concerns.

Secondly, Sill teaches the use of a conical cap (17) connecting the T piece to the collection chamber, as shown in Figure 2.

In view of the Sill patent, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the collection chamber of Wade with the conical



Art Unit: 3753

cap of Sill, in order to provide a collection chamber cap that extend the life of the chamber by not rusting as quickly as in the surface were flat.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Wallis (US 5,407,091).

Regarding claim 7, APA teaches all of the claimed invention, but lacks a conical receptacle is fitted to the lower end of the collection chamber which houses the outlet.

Wallis teaches the use of a conical receptacle is fitted to the lower end of the collection chamber, which houses the outlet, as shown in Figure 2.

In view of the Wallis patent, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the collection chamber of Wade with the conical receptacle of Wallis, in order to provide a chamber which would drain out all of the possible rainwater due to the conical shape.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over APA. Regarding claim 10, APA teaches all of the claimed invention, but lacks the plurality of floating balls within the collection chamber. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a plurality of floating balls, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Smith (US 6,357,183) discloses similar collection systems, which

Art Unit: 3753

discuss roof area and tank capacity. Hart (US 6,182,680), Corella (US 5,046,529), Taylor (US 5,730,179), and Hosoya (2004/0108278) disclose similar types of rainwater collection systems.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig Price whose telephone number is (571) 272-2712. The examiner can normally be reached on 8AM - 5PM M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Blau can be reached on (571) 272-4406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CP



November 28, 2005



**STEPHEN BLAU**  
**PRIMARY EXAMINER**